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PTO/SB/33 (07-05)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>P21570</b>
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		<p>Application Number <b>09/986,305</b></p> <p>Filed <b>8 November 2001</b></p> <p>First Named Inventor <b>Bruno BORSOI</b></p> <p>Art Unit <b>3764</b></p> <p>Examiner <b>Huong Q. PHAM</b></p>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record. **32,674**  
Registration number \_\_\_\_\_

attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

**James L. Rowland**

Typed or printed name

**703-716-1191**

Telephone number

**9 October 2007**

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

<input type="checkbox"/>	*Total of _____ forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT APPLICATION  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Bruno BORSOI	)	Group Art Unit 3764
Appln. No.	:	09/986,305	)	Examiner Huong Q. Pham
Docket No.	:	P21570	)	Confirmation No. 5187
Customer No.	:	07055	)	
Filed	:	November 8, 2001	)	
Title	:	JOINT PROTECTIVE ARTICLE	)	

**ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW**

U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop *AF*  
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Sir:

Pursuant to the Official Gazette Notice published on July 12, 20005, entitled "New Pre-Appeal Brief Conference Pilot Program," Applicants herewith present arguments which accompany a completed and signed form PTO/SB/33, which form is entitled "Pre-Appeal Brief Request for Review."

In addition, being filed concurrently herewith are (1) a Notice of Appeal in compliance with 37 CFR §41.31; (2) a Request for Extension of Time in compliance with 37 CFR §1.136(a); and (3) payment in the amount of \$1560.00, which includes \$510.00 for the appeal fee pursuant to 37 CFR §41.20 and which includes \$1050.00 for the extension of time fee pursuant to 37 CFR §1.17(a)(3).

Further, Applicant is concurrently filing a Request for Withdrawal of Premature Final Office Action in view of a new ground of rejection that was not necessitated by Applicant's reply thereto.

**ARGUMENTS**

**A. Withdrawal of "New Matter" Objection to Subject Matter of Claim 54**

Because the objection under 35 USC §132 is premised upon the final paragraph of claim 54 not being supported by the original disclosure, Applicant herewith treats the objection as an appealable issue, susceptible to a rejection for alleged failure to comply with the written description requirement of 35 USC §112, first paragraph.

The objection/rejection is in error. As Applicant pointed out in the fifth paragraph on page 27 of his reply filed on December 26, 2006, claim 54 provides a description of tibial and instep supports (such as elements 100, 101 in the drawing), whereby their lengths are greater than their thicknesses. Because support for the subject matter is provided at least in the drawings, withdrawal of the objection/rejection is requested.

**B. Withdrawal of Rejection of Claims 50-52 Under 35 USC §112, Second Paragraph, for Indefiniteness**

Applicant submits that the rejection of claims 50-52 for indefiniteness is in error.

The rejection is stated as follows: “‘opposed transverse sides’ lack proper antecedent basis. It’s unclear what structures are these ‘opposed transverse sides’.”

First, there is no antecedent basis for the expression “opposed transverse sides” in claims 50-52 because the expression is newly introduced in those claims.

Second, with regard to the structures of the “opposed transverse sides” in claims 50-52, as Applicant pointed out in the second paragraph on page 27 of his reply of December 26, 2006, the language of claims 50-52 “call for the length of the frame, which extends in a direction between the opposed ends of the frame, to be greater than the transverse width of the frame.” Further, the end of paragraph 0037 (see page 2 of Applicant’s reply of December 26, 2006) provides a further description that the width extends transverse to the length of the frame.

**C. Withdrawal of Rejection for Anticipation Based Upon DACHGRUBER**

The rejection of claims 1, 3, 8, 9, 13, 14, 16, 18, and 50 as being anticipated by DACHGRUBER is erroneous, inasmuch as a rejection under 35 USC §102 requires each and every claim limitation being found, either expressly or inherently, in the cited reference. DACHGRUBER fails to disclose, expressly or inherently, at least the following limitation appearing in claim 1, lines 12-14: “*means for limiting bending of the frame and limiting bending of the joint along said bending direction at said predetermined angle of bending.*”

In the fourth line from the bottom of page 3 of the Office action and in the first line of page 4, the rejection includes the assertion that the device 24 of DACHGRUBER limits bending “*to some degree.*” As explained in Section C.1. on pages 19-23 of Applicant’s reply of December 26, 2006, limiting flexion *to some degree* is not claimed. Further, Applicant questions the meaning of limiting flexion “*to some degree.*” A limit is a boundary; the boundary is either met or not met. In other words, the claimed abutment acts in a binary way, i.e., at a given bending level the abutment functions totally; prior to that, more bending can occur. In other words, it is 0 or 1. Instead of limiting flexion to some degree, and consistent with a purpose of the invention, as expressly recited

in claim 1, i.e., to avoid hyper-flexion of the joint beyond a predetermined angle of bending while the protective article is in a bent position, flexion of joint protective article is *stopped*, i.e., a boundary of flexing is reached.

DACHGRUBER, on the other hand, merely discloses a stiffener for a snowboard boot which stiffens the flexing of the boot, intended to improve board control, but, compared to the prior art, provides greater comfort for the wearer. See, e.g., column 2, lines 8-12, of DACHGRUBER. No intention is provided for limiting flexing of the boot. No concern is expressed for preventing hyper-flexing of a user's joint. No embodiment is disclosed by DACHGRUBER to prevent, i.e., limit, flexing of the boot. In fact, as Applicant explained near the middle of page 22 of his reply of December 26, 2006, the apertures 100 and grooves 98 of DACHGRUBER are intended to allow – not limit – flexing. Elements 102 (newly referenced in the final Office action), e.g., can be fitted into apertures 100 (see column 8, lines 4-8), although they merely adjust the stiffness of the device 24; they are not disclosed as *limiting* – i.e., *stopping* – flexing. The comment in lines 6 and 7 from the bottom of page 9 of the Office action, viz., “Note that the stiffener 24 [of DACHGRUBER] is there to assist in limiting flexion” is unsupported. It is mere speculation; not anticipatory.

#### D. Withdrawal of Rejection for Anticipation Based Upon RATHMELL '578

The rejection of claims 1-9, 14, 16-23, and 25-52 under 35 USC §102(b) as being anticipated by RATHMELL '578 is erroneous. See Section C.3., on pages 24-25 of Applicant's reply of December 26, 2006. Applicant's invention *limits* the range of movement to a predetermined angle (between 30 and 45 degrees in dependent claim 16); the invention of RATHMELL '578 modifies the *flexibility* of the movement through an unspecified angle.

The assertion in the rejection (see page 5 of the final Office action) that RATHMELL '578 comprises means for limiting bending of the frame at a predetermined angle to prevent hyper-flexion, is also untrue and can only be based upon speculation.

Regarding claim 3, the final line of page 5 of the final Office action newly identifies element 5 of RATHMELL '578 as a “membrane.” There is no disclosure that element 5 is “a flexible and substantially inextensible membrane,” as recited by Applicant.

Further, claim 18 calls for the frame to overlie a substantially inextensible membrane during bending from an unbent to a bent position of the protective article. By contrast, the “very flexible” (see column 2, lines 31-32) membrane 5 of RATHMELL '578 is not inextensible, i.e., it is constructed with deep corrugations to seal the space between the upper and lower sections 1, 2.

Further, claims 50-52 call for the length of the frame to be greater than its width, which is not taught by RATHMELL '578.

**E. Withdrawal of Rejection for Anticipation Based Upon RATHMELL '059**

The rejection of claims 1, 2, 4, 5, 8, 9, and 14 under 35 USC §102(b) as being anticipated by RATHMELL '059 is erroneous. See, e.g., Section C.2., on pages 23-24 of Applicant's reply of December 26, 2006. Applicant's invention *limits* the range of movement to a predetermined angle; the invention of RATHMELL '059 only modifies the *flexibility* of movement.

Further, the rejection refers to elements 4 and 5 of RATHMELL '059 as corresponding to Applicant's "rigid frame." However, in column 1, lines 35-39, RATHMELL '059 explains that the corrugated sections 4 enhances flexibility.

In claim 5, Applicant calls for the thickness of the frame in the bending zone is greater than the thickness of the supports (such as supports 100, 101 in the exemplary drawings). RATHMELL '059 fails to teach or suggest this.

**F. Withdrawal of Rejection for Obviousness Based Upon RATHMELL '578**

The rejection of claims 13 and 15 under 35 USC §103(a) as being unpatentable over RATHMELL '578 is erroneous.

First, the rejection is believed to be erroneous at least for the reason given above in connection with the rejection for anticipation based upon RATHMELL '578.

Second, although "boot-tightening means" might be well-known in general, claim 13 recites more than merely a boot having a tightening means. More particularly, claim 13 calls for a boot-tightening means to extend over the rigid frame, which is positioned on the front of the ankle, as specified in parent claim 8, as well as a complementary cooperating mechanism engaged with the boot-tightening means.

If a boot-tightening means were to be placed over that which is regarded in the Office action as a rigid frame of RATHMELL '578, Applicant submits that it would appear to interfere with the flexing of the boot that is provided by means of elements 5, 8, etc. That is, one skilled in the art would have had no reason to place a tightening means in the position specified and no reason is given in the rejection, nor is there any evidence of such structure being within the common sense of one skilled in the art.

**G. Withdrawal of Rejection for Obviousness Based Upon DACHGRUBER, RATHMELL '578 and FILICE**

The rejection of claims 2, 4-7, 15, 17, 19-23, 25-40, 43, 46, 47, 49, and 52-54 under 35 USC §103(a) as being obvious over DACHGRUBER in view of RATHMELL '578 and FILICE is erroneous.

The rejection fails to present a *prima facie* case of obviousness. In rejecting claims for obviousness, the Office bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also, In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Applicant. *Id.* at 1445, 24 USPQ2d at 1444. *See also, Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

In the Manual of Patent Examining Procedure, Section 706.02(j) (see also Section 2142), the difference(s) in the rejected claims over the applied references is(are) to be identified and the proposed modification(s) of the references is(are) to be set forth. In the subject rejection, although claims 2, 4-7, 15, 17, 19-23, 25-40, 43, 46, 47, 49, and 52-54 are identified as rejected for obviousness, only claim 53 is mentioned in the explanation of the rejection.

The foregoing notwithstanding, none of the cited references teach, suggest, or provide any evidence based upon the common sense of one skilled in the art, of the claimed invention, including the *limiting* of bending, as explained above.

Further, with regard to a modification of DACHGRUBER to have beveled notches and to thicken the bending zone, no reason is provided in the rejection as to why it would have been obvious, as required by *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), without reliance upon an improper use of hindsight.

#### SUMMARY AND CONCLUSION

At least for the reasons given above, reconsideration and withdrawal of the rejections are kindly requested.

The Commissioner is authorized to charge any fee required for timeliness and/or completeness to Deposit Account No. 19-0089.

Respectfully submitted,  
Bruno BORSOI



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October 9, 2007  
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